

REMARKS

In this Amendment, Applicants have amended Claim 1 to delete the phrase “phenol/hydrogenated terpene copolymer resins” in the Markush group.

No new matter has been added and thus, entry of the Amendment is respectfully requested. Upon entry of the Amendment, Claims 1 and 2 will be all the claims pending in the application.

Claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Dobashi et al.

It was asserted that a “hydrogenated terpene-phenol resin” in Dobashi et al is a copolymer as set forth in the present claims, specifically, the second copolymer in the Markush group recited in Claim 1.

Applicants respectfully submit that Claims 1 and 2 as amended are not anticipated or rendered *prima facie* obvious by Dobashi et al. In this Amendment, as mentioned above, Applicants have amended Claim 1 to delete the recitation of “phenol/hydrogenated terpene copolymer resins” in the Markush group.

Dobashi et al discloses a coating protective film comprising a substrate, and a pressure sensitive adhesive layer which contains a rubber and a tackifier, such as a hydrogenated terpene-phenol resin.

However, Dobashi et al does not disclose or suggest the use of styrene/hydrogenated terpene copolymer resins, hydrogenated aliphatic/aromatic copolymer petroleum resins and/or aliphatic/aromatic copolymer petroleum resins, as presently claimed.

As clearly shown in the Table on page 19 of the present specification, the sheets containing styrene/hydrogenated terpene copolymer resins (Examples 1-4, 6 and 7) and aliphatic/aromatic copolymer petroleum resin (Example 5) are excellent in the fouling test of the paint films following the removal of the protective sheets, as compared to the sheets containing no copolymer (Comparative Examples 1 and 2) and hydrogenated terpene resin (Comparative Example 3).

Further, as described on page 6 of the specification, styrene/hydrogenated terpene copolymer resins are preferred from the standpoints of long-term stability of pressure-sensitive adhesive properties, hue, adhesion to paint films, etc. However, Dobashi et al does not appreciate these advantages.

In view of the above, the present invention is not anticipated or rendered *prima facie* obvious by Dobashi et al, and thus, the Examiner is respectfully requested to reconsider and withdraw the rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 09/874,314

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Fang Liu
Registration No. 51,283

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: May 19, 2003

APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

1. (Amended) A sheet for protecting a paint film, said sheet comprising a substrate and formed on one side thereof a rubber-based pressure-sensitive adhesive layer which comprises a rubbery polymer and incorporated therein at least one copolymer selected from the group consisting of styrene/hydrogenated terpene copolymer resins, ~~phenol/hydrogenated terpene copolymer resins,~~ hydrogenated aliphatic/aromatic copolymer petroleum resins and aliphatic/aromatic copolymer petroleum resins.